

REMARKS

Claims 1-3, 5 and 7-20 are pending in this application. By this Amendment, claims 1, 2, 5, 7 and 18 are amended to recite features supported in the specification on page 14, line 11 – page 15, line 24. No new matter is added by any of these amendments.

Applicants gratefully acknowledge that the Office Action indicates that claims 1-3, 5, 7-13 and 18 contain allowable subject matter. However, Applicants assert that all of pending claims 1-3, 5 and 7-20 are allowable for the reasons discussed below.

Reconsideration based on the following remarks is respectfully requested.

**I. Claims 1, 18 Satisfy the Requirements under 35 U.S.C. §112, second paragraph**

The Office Action rejects claims 1 and 18 under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1 and 18 have been amended to obviate this rejection in view of the Examiner's helpful comments. Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

**II. Claims 14-17, 19 and 20 Define Patentable Subject Matter**

The Office Action rejects claims 14-17, 19 and 20 under 35 U.S.C. §102(e) over U.S. Patent 6,157,706 to Rachelson. This rejection is respectfully traversed.

Rachelson does not teach or suggest an internet facsimile machine capable of executing facsimile transmission via an internet to an addressee using a computer installed with an application program for execution of internet facsimile transmission, including analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation, reading means for reading the data of address information analyzed by the analyzing means, and format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission, wherein the application program for execution of internet facsimile

transmission and the electronic mail application program are independently operating application programs using the computer , as recited in claim 14.

Rachelson also fails to teach or suggest an internet facsimile machine capable of executing facsimile transmission via an internet to an addressee using a computer installed with an application program for execution of internet facsimile transmission, including an analyzing circuit for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation, a reading circuit for reading the data of address information analyzed by the analyzing circuit, and a format converting circuit for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission, wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer, as recited in claim 19.

Rachelson further does not teach or suggest a recording medium for recording a program for operating a facsimile machine using a computer installed with an application program for execution of internet facsimile transmission, the program realizing the functions of analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation, reading means for reading the data of address information analyzed by the analyzing means, and format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission, wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer, as recited in claim 20.

Instead, Rachelson discloses a function of converting an e-mail address and a facsimile number. Specifically, Rachelson teaches an address book provided in EPO

Location A 112, and that a facsimile user 110 has functions of fetching out of a list of addresses, adding and deleting addresses. See col. 7, lines 33-47 and Fig. 1 of Rachelson.

Accordingly, Rachelson fails to teach or suggest the analyzing means and format converting means connected via a city telephone city 103 to the EPO location A 112. Consequently, the facsimile user 110 and the EPO location A 112 are distinct in Rachelson, thereby teaching away from Applicants' claimed features thus does not anticipate Applicants' claimed features.

A claim must be anticipated for a proper rejection under §102(a), (b) and (e). This requirement is satisfied "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP §2131. The Office Action fails to show that Rachelson anticipates Applicants' claimed features.

For at least these reasons, Applicants respectfully assert that independent claims 14, 19 and 20 are now patentable over the applied reference. Dependent claims 15 and 16 are likewise patentable over the applied reference for at least the reasons discussed as well as for the additional features they recite. Consequently, all the claims are in condition for allowance. Thus, Applicants respectfully request that the rejection under 35 U.S.C. §102 be withdrawn.

### **III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Gerhard W. Thielman  
Registration No. 43,186

JAO:GWT/gwt

Date: June 10, 2003

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--